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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,595	03/19/2004	Eric W. Rubie	55508-301656	9551
25764 7590 12/22/2006 FAEGRE & BENSON LLP PATENT DOCKETING 2200 WELLS FARGO CENTER 90 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-3901			EXAMINER MILLER, CHERYL L	
			ART UNIT 3738	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/22/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/804,595	Applicant(s) RUBIE ET AL.	
	Examiner Cheryl Miller	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34, 38-44, and 47-50 is/are rejected.
- 7) ☒ Claim(s) 35-37, 45 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/16/04</u> . | 6) <input checked="" type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites the limitation "the elastomeric layer" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 50 depends upon claim 49 and inherits all problems associated with the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-5, 8-20, and 22-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,712,860 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are merely broader than the patent claims. Once an applicant has received a patent on the more specific claims, the broader application claims are anticipated by the specific patent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 8-10, 14, 15, 25-27, 33, 38, 39, 42-44, and 47 are rejected under 35

U.S.C. 102(b) as being anticipated by Merlette (US 4,959,073, cited in IDS). Referring to the first group of claims, Merlette discloses a lower leg prosthesis (10; fig.1) comprising a lower foot plate (20) spaced from an upper foot plate (16) each elongate and flexible, and an elastomeric layer (24) attaching the lower to the upper foot plate, the elastomeric layer extending *substantially* across an upper surface of the lower plate (see fig.1, 6). Merlette discloses the elastomeric layer to extend substantially to a periphery of the lower plate. Merlette discloses the elastomeric layer (24) to extend posterior to the upper plate (16; seen in fig.6). Merlette

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discloses a forefoot plate (anterior portion of 20) and a heel plate (posterior portion of 20), wherein the plates are made of high strength fibers (col.2, lines 39-42; col.3, lines 66-68).

Referring to the second group of claims, Merlette discloses a lower leg prosthesis comprising a curved upper foot plate, a lower foot plate, and an attachment device (14; 82) coupled to the upper foot plate (16; 84), the device having a lower surface conforming to the slope of the upper foot plate (see attachment 1). Merlette discloses a mounting portion that is horizontal and wherein the attachment device is bonded to the upper plate (see fig.9). Merlette discloses an elastomeric layer between the two plates (see above).

Claims 1, 3, 4, 8, 10, 11, 14, 15, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips (US 5,800,569, cited in IDS). Phillips discloses a lower leg prosthesis (100; fig.4) comprising a lower foot plate (110) spaced from an upper foot plate (112) each elongate and flexible, and an elastomeric layer (114) attaching the lower to the upper foot plate, the elastomeric layer extending *substantially* across an upper surface of the lower plate (see fig.4). Phillips discloses the elastomeric layer to extend *substantially* to a periphery of the lower plate. Phillips discloses the elastomeric layer (114) to solely bone the upper and lower plates. Phillips discloses the plates to be formed of high strength fibers (col.3, lines 47-53) and the elastomeric layer to be made of polyurethane (col.2, lines 27-29).

Claims 1-7, 10, 12-16, 18, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Herr et al. (US 5,701,686). Herr discloses a lower leg prosthesis (fig.22) comprising a lower foot plate spaced from an upper foot plate each elongate and flexible, and an

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elastomeric layer (25, 27; shown in detail in fig.8a, 9, 10, 11; shown compressing in figs.10, 11; disclosed to spring; col.10, lines 1-7) attaching the lower to the upper foot plate, the elastomeric layer extending *substantially* across an upper surface of the lower plate. Herr discloses the elastomeric layer to extend *substantially* to a periphery of the lower plate. Herr discloses the elastomeric layer to be narrower in width than the two plates, either convex (when considering only 27 to be the elastomeric layer) or *generally* concave (when 27 and 25 are considered to be the elastomeric layer, the middle has an indentation that is *generally* concave; see figs.9-11). Herr discloses a forefoot lower plate and a heel lower plate separated by a first gap, the elastomeric layer also having a gap at the same location longitudinally (see fig.22). Herr discloses the plates to be made of high strength fibers (col.3, lines 7-11).

Claims 25-34 and 38-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Mosler et al. (US 6,767,370 B1). Mosler discloses a lower leg prosthesis comprising a curved upper plate (10), a lower plate (24), and an attachment device (4) coupled and conforming to the upper plate (see fig.7). Mosler discloses the attachment device to comprise a wedge shaped portion conforming to the upper plate, a horizontal mounting portion and a pyramid projection, all seen in fig.7.

Claims 25-26, 28-33, 39, 40, 41, and 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen (US 5,507,838). Chen discloses a lower leg prosthesis comprising a curved upper plate (40, 41), a lower plate (30, 31), and an attachment device (4; 42) coupled and conforming to the upper plate (see fig.4, 5). Chen discloses the attachment device to comprise a wedge shaped portion conforming to the upper plate, a horizontal mounting portion and a pyramid projection (see attachment 2). Chen discloses a weight reducing cutout in a forward

portion of the attachment device (see attachment 2; figs. 4, 5). Chen discloses a forefoot (30) and heel portion (31) being separated by a gap (near where 6 is located).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herr et al. (US 5,701,686). Herr has shown a gap width (fig.22) and elastomeric layer thickness (fig.8a, 9-11), however is silent to mention the exact dimensions claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the dimensions claimed since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Allowable Subject Matter

Claims 35-37 and 45-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 49-50 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Claims 19 and 22 would be allowable if the double patenting rejection is overcome.


Conclusion

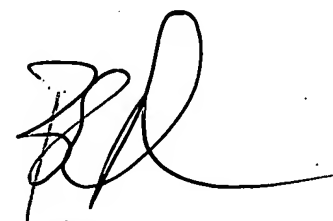
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Cheryl Miller


BRUCE SNOW
PRIMARY EXAMINER

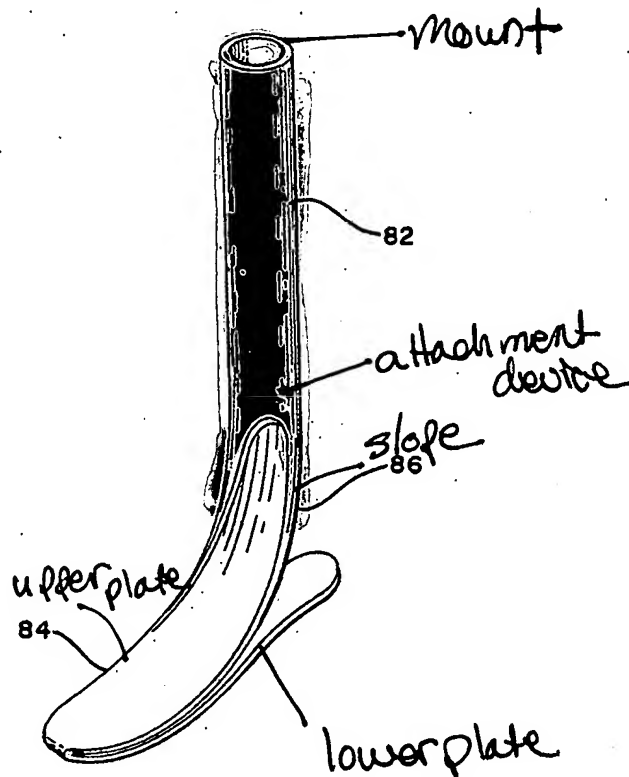


FIG. 9

Attachment #2 (marked up)

U.S. Patent

Apr. 16, 1996

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5,507,838

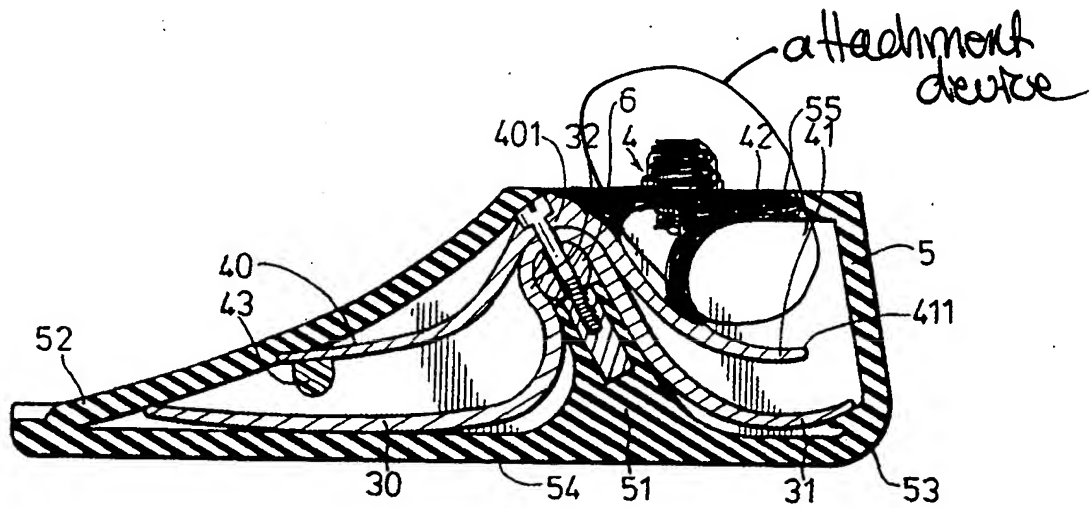


FIG. 4

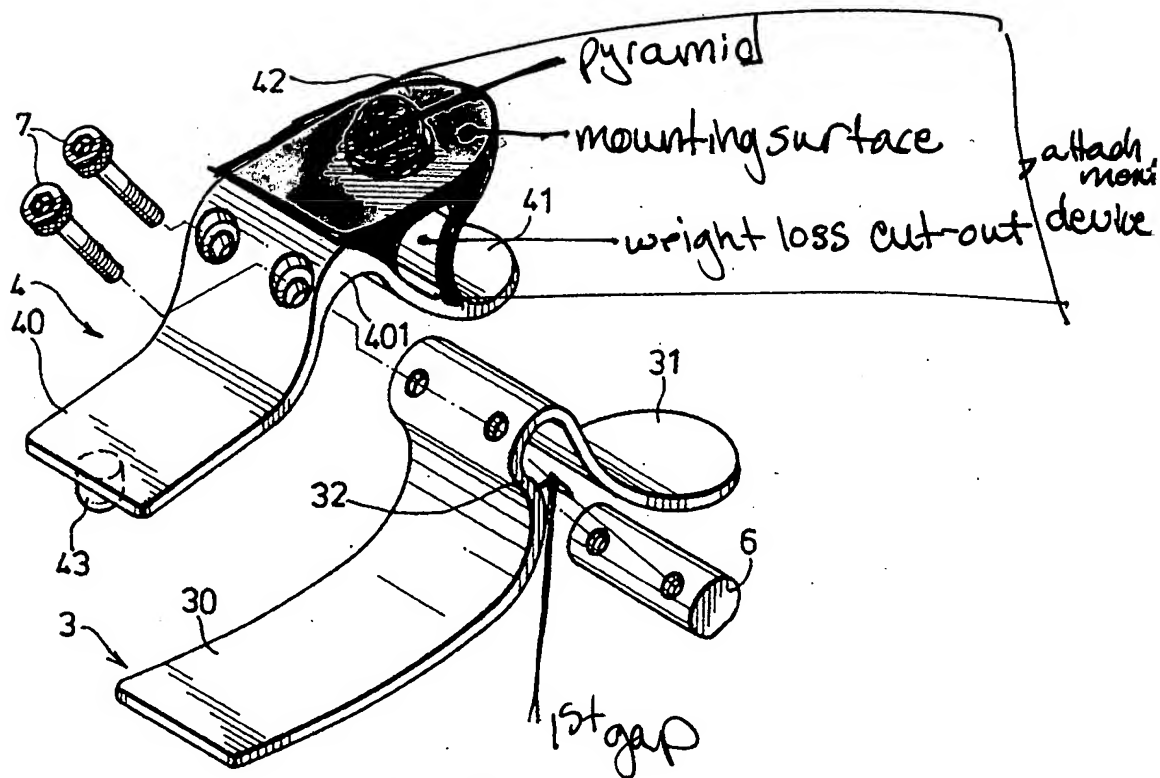


FIG. 5